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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,743	01/27/2004	Nicole M. Weiss	UM-08483	1087
72960	7590	10/15/2007		
Casimir Jones, S.C. 440 Science Drive Suite 203 Madison, WI 53711			EXAMINER LEWIS, KIM M	
			ART UNIT	PAPER NUMBER
			3772	
			MAIL DATE	DELIVERY MODE
			10/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,743

Applicant(s)

WEISS, NICOLE M.

Examiner

Kim M. Lewis

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-19 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Response to Amendment

1. The amendment filed 7/2/07 has been received and made of record. As requested claims 8 and 9 have been cancelled, and claims 13-19 have been added.
2. Claims 1-7 and 10-19 are pending in the instant application.

Claim Rejections - 35 USC § 112

3. Claims 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Portions of the structural elements were previously recited in claim 1. For example, an upper portion, a lower portion and a rotation component. Since these elements were previously recited, it is unclear if applicant is claiming an additional upper portion, lower portion and rotation component.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-7 and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 2003/01256651 A1 ("Hopkins et al.").

Regarding claim 1, Hopkins et al. disclose a supination/pronation forearm orthotic therapy device, comprising an upper portion (12) configured to attach to an upper arm, a lower portion (11) configured to attach to a forearm, and a rotation component (13, 40, 41) positioned around said lower portion, wherein said rotation component is configured to exert static progressive stretch in the form of a rotational force upon a forearm contained in said lower portion (para 0015), wherein said static progressive stretch (force) comprises supinated static progressive stretch (force) and pronated static progressive stretch (force).

Regarding claim 2, the rotation force serves to stretch.

Regarding claim 3, the orthotic device can be a free motion device with pin (22) removed so as to not limit rotation of the elbow joint.

Regarding claim 4, it is inherent that the lower portion comprises a mechanical axis and the forearm comprises an anatomical axis, wherein the mechanical axis matches the anatomical axis of the forearm.

As regards claims 5-7, Hopkins et al. disclose the orthotic device of claim 1, but fail to teach the orthotic forearm device of Claim 1, wherein said upper portion and said lower portion comprise a thermoplastic coating, wherein said thermoplastic coating comprises polyethylene plastic, and wherein said polyethylene plastic is greater than 3/16 inch thick.

Absent a critical teaching and/or a showing of unexpected results derived from providing the upper and lower portion of the device with a 3/16 inch thick polyethylene plastic coating, the examiner contends that such a coating is an obvious design choice which does not patentably distinguish applicant's invention. Moreover, it has been held that a selection of a known material based upon its suitability for the intended use is a design consideration within the level of ordinary skill in the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

As regards claim 10, Hopkins et al. disclose a method for treating a forearm by mere use of the disclosed orthotic device. The device as discussed above in the rejection of claim 1 is provided, fitted by being placed on the user, and either a static or dynamic rotational force, equivalent to applicant's claimed static progressive stretch, is exerted on the forearm.

Regarding claim 11, note the upper portion (12), lower portion (11), connecting component (20), and rotation component (13, 40, 41).

Regarding claim 12, Hopkins et al. disclose the is supinated or pronated.

Allowable Subject Matter

6. Claims 13-19 are allowed.

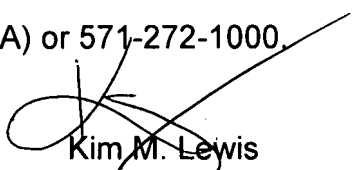
Response to Arguments

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Wednesday to Friday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kim M. Lewis
Primary Examiner
Art Unit 3772

kml
October 11, 2007